

REMARKS

Claims 1-22 are pending and at issue in this patent application. Of these, claims 1, 16, and 21 are independent. Applicant respectfully requests reconsideration and favorable action in this case.

Applicant respectfully traverses the rejection of claims 1-22 as anticipated by U.S. Patent No. 6,052,735 to Ulrich et. al. ("Ulrich").

Each of the pending claims recites, *inter alia*, a method, a device or a computer readable medium for selecting first personal information management (PIM) data as a primary data field for display on a personal digital assistant (PDA) and second PIM data as a subordinate data field for storage and later retrieval. Ulrich does not disclose selecting second PIM data as a subordinate data field for storage and later retrieval. Therefore, Ulrich cannot anticipate pending claims 1-22.

While Ulrich discloses a system and a method for synchronizing e-mail messages between a desktop computer and a mobile device, Ulrich does not disclose selecting second PIM data as a subordinate data field for storage and later retrieval. Ulrich merely discloses a synchronization system that compares time stamps of data fields stored in a mobile device and a desktop computer, determines and retains the most current data field value, and deletes any older field value. Because Ulrich does not preserve at least two alternative data values for the same field type, it is impossible to designate a primary and a subordinate data field. Consequently, Ulrich cannot disclose selecting a first personal information management (PIM) data as a primary data field for display on a personal digital assistant (PDA) and a second PIM data as a subordinate data field for storage and later retrieval, as recited by the pending claims and thus, Ulrich cannot anticipate the pending claims.

Furthermore, although not asserted in the Office action, Ulrich cannot render any of the pending claims obvious because Ulrich does not, in any manner, suggest that it would be desirable to retain subordinate field values. In fact, Ulrich does not even recognize that there is a problem with replacing and deleting older versions of data with more recent versions based on a time stamp. As discussed in the specification at pages 1-2, prior art systems, such as Ulrich, will delete the older field data permanently during synchronization. This approach, however, fails to account for situations in which a data field may be modified by multiple persons, and no one version may be the desired version. In this case data will be lost automatically because the prior art systems will only retain the latest version. Another situation arises when incorrect data is entered on top of correct data. In the prior art systems, once synchronization occurs, the older, correct data may be permanently lost. Thus, Ulrich actually teaches away from the claimed invention.

These problems are alleviated by using the subordinate field value recited by the pending claims. Subordinate field values allow users to access conflicting records for later editing and substitution by the user, thereby decreasing the chances of permanent data loss. Moreover, retaining secondary values allows a user to clean up his records at the user's own leisure, without having to scrutinize data before it is entered for fear of eminent data loss. Thus, unlike the immediate replacement synchronization process of Ulrich, the preservation of secondary, subordinate field values reduces the chances of data loss and provides user confidence.

It is clear that the prior art must make a suggestion of or provide an incentive for a claimed combination of elements to establish a prima facie case of obviousness. See, *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). This principle holds true even if the applied art could be modified to

produce the invention recited by the pending claims. See, *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") Because Ulrich does not disclose or even suggest the desirability of retaining secondary, subordinate field values, Ulrich cannot render obvious any of claims 1, 16, or 21.

Claims 2-15, 17-20 and 22 are dependent on claims 1, 16, and 21, respectively, and are therefore allowable for the reasons set forth above and because the cited art fails to disclose or suggest the elements of these claims in the claimed combinations.

CONCLUSION


Applicant submits that this case is in a condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and allowance of rejected claims 1-22.

Applicant also requests a one month extension of time under 37 C.F.R. 1.136(a) and include, herewith, a check in the amount of \$55.00 for the one month extension. Although Applicant believes that no other fees are due, the Commissioner is hereby authorized to charge any fees or to credit any overpayments to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicant respectfully requests that the Examiner call its attorney at the number listed below.

Respectfully submitted,

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